

REMARKS

In response to the Office Action mailed July 8, 2009 (hereinafter, "Office Action")¹, the response for which is due with a Petition for Extension of Time (submitted herewith) on November 9, 2009, November 8, 2009 being a Sunday, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

I. Interview Summary

Applicant thanks Examiner Boyce for the courtesies shown during a telephonic interview conducted on October 15, 2009. In attendance were Examiner Boyce and counsel for Applicant, Meghan R. Rooney (Reg. No. 57,261) of Accenture and Maura K. Moran (Reg. No. 31,859) of Finnegan. The substance of the interview is made of record in the remarks below.

II. Status and Disposition of the Claims

In the instant Application, claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-134 are currently pending². Of these pending claims, claims 21, 50, and 79 are independent. In the Office Action, the following action was taken:

- the previously pending rejections of claims 21-39, 41-45, 47-49, and 123 under 35 U.S.C. § 101 are withdrawn;
- the previously pending rejections of claims 21-39, 41-45, 47-68, 69-97, 99-103, 105-107, and 123-125 under 35 U.S.C. § 112, first paragraph, are withdrawn; and

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² The Office Action does not include pending claims 126-134 in its list of pending claims on page 1, nor in the list on page 1 of claims rejected. However, it does list claims 126-134 in its Detailed Action discussion of the rejection at pages 2 and 3. Therefore, in this Amendment and Response, Applicant treats claims 126-134 as pending and included in the rejection under 35 U.S.C. § 103(a).

- all of the pending claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,021,397 to Jones et al (hereinafter, "*Jones*") in view of U.S. Patent No. 5,918,217 to Maggioncalda et al (hereinafter *Maggioncalda*).

III. Replacement Figures

In the Examiner Interview, Examiner Boyce requested that Figures 7, 8, and 9 be replaced. Applicant submits that, as shown in the Amendment and Response filed April 6, 2009, the figures are of a condition as to permit reasonable examination of the application. Nevertheless, new Figures 7, 8, and 9 have been submitted here as requested by the Examiner.

Support for the new replacement Figures 7, 8, and 9 may be found in the Figures 7, 8, and 9 as originally filed, and in the Specification, *inter alia*, at page 8, lines 3-9; page 12, lines 27-31; page 13, lines 1-9; page 29, lines 9-10; page 31, lines 4-24; page 33, lines 13-18; and page 41, lines 1-25. No new matter is introduced.

IV. Amendments to Claims

In this Amendment and Response, claims 21, 50, 79, and 126-134 have been amended to improve readability.

Support for the claim amendments may be found, among other places, in the Specification as filed at page 33, lines 8-9. Upon entry of the amendments, claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-134 will remain pending in this application.

Applicant respectfully requests that this Amendment and Response be entered by the Examiner, placing the claims in condition for allowance. This Amendment and Response should allow for immediate action by the Examiner.

V. Response to Rejections

Based on the reasoning presented below, Applicant respectfully traverses the above-identified rejections and requests the withdrawal of the rejections, reconsideration of the application, and the timely allowance of the pending claims.

Applicant respectfully traverses the rejection of the pending claims under 35 U.S.C. §103(a) for allegedly being obvious from *Jones* in view of *Maggioncalda*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A. The rejection of claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, 105-107, and 123-134 should be withdrawn.

Claim 21 calls for a combination including, for example: "pictorially presenting the goals compris[ing] displaying a plurality of images, each of the images representing a goal, and at least one of the images comprising a picture of the goal." *Jones* fails to teach or suggest this element. The Office Action cites *Jones* col. 7, lines 36-43 as teaching at least one image of goals comprising a picture by showing an "LCD for displaying graphical depictions of expected portfolio performance, asset allocation, etc., including charts presented to the user." Office Action at 4. However, a graphical depiction of performance or allocations is not a "picture of the goal", as recited in amended claim 21.

Maggioncalda does not make up for this deficiency. *Maggioncalda* was cited by the Office Action as allegedly showing element (g) in claim 21:

"(g) graphically presenting to the user via the display device the impact of the adjustment";

“by again presenting simultaneously the image of the one of the selected goals as adjusted and the images of the remaining goals as impacted”;

“wherein graphically presenting the impact of the adjustment comprises altering the appearance of a picture of the one of the remaining goals to reflect an inverse relationship between the time indicia or the quality indicia of the adjusted goal and the time indicia or the quality indicia of the one of the remaining goals, and to display an extent of the impact on the one of the remaining goals.”

Even assuming the Office Action's characterization of *Maggioncalda* is correct, which Applicant does not concede, *Maggioncalda* does not disclose “pictorially presenting the goals compris[ing] displaying a plurality of images, each of the images representing a goal, and at least one of the images comprising a picture **of the goal.**” Claim 21, emphasis added. *Maggioncalda* discloses the use of icons 750 “to communicate the likelihood of achieving the goal 720. . . . While in this example a weather theme is employed to communicate probabilities to a user, it is appreciated various other metaphors could be used.” *Maggioncalda* at col. 13, lines 10-42. It can be seen then, that *Maggioncalda* discloses using icons as metaphors to communicate probabilities. *Maggioncalda* does not disclose “displaying . . . a picture of the goal,” as recited in amended claim 21.

In view of the differences between the prior art and the claimed invention set forth above, the scope and content of the prior art has not been properly determined. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 21 and related dependent claims 22-39, 41-45, 47-49, 123, and 126-128 under 35 U.S.C. §103 as being obvious from *Jones* in view of *Maggioncalda* is thus improper and should be withdrawn.

Independent claims 50 and 79, while of different scope from claim 21, recite claim elements similar to those recited in claim 21. Accordingly, the rejection of claim 50 (and related claims 51-68, 70-74, 76-78, 124, and 129-131) and claim 79 (and

related claims 80-97, 99-103, 105-107, 125, and 132-134) as being obvious from *Jones* in view of *Maggioncalda* is also improper and should be withdrawn.

B. The rejection of claims 126-134 should be withdrawn.

For at least the reasons stated above with respect to claim 21, claims 126-128 are also allowable as they depend from claim 21, and claims 129-131 and 132-134 are also allowable as they depend from claims 50 and 79, respectively. In addition to the arguments presented above, dependent claims 126-134 are allowable for additional reasons.

Claims 126-128 recite, respectively,

- “changing a level of transparency of a display of the picture to reflect an adjusted priority of the one of the remaining goals”;
- “changing a level of transparency of a display of the picture to reflect an adjusted amount of time expected to achieve the one of the remaining goals”; and
- “replacing the picture with another picture of the goal and representative of an adjusted expensiveness of the one of the remaining goals.”

By not citing to any section of *Maggioncalda* or *Jones*, the Office Action confirms that neither *Jones* nor *Maggioncalda* disclose showing changing an intensity of a display or replacing the picture of a goal with another picture of a goal. The Office Action cites the weather icons 760-790 of *Maggioncalda* as disclosing altering “in a pictorial fashion . . . to represent certain levels of probability of achieving goals.” Office Action at page 24. However, as noted above, displaying the weather icons to represent levels of probability is not “displaying . . . a picture of the goal,” as recited in amended claim 21. In addition, displaying the weather icons is not “changing a level of transparency of a display of the picture [of the goal],” nor is it “replacing the picture with another picture of the goal.”

The Office Action simply continued,

“It would have been obvious to one of ordinary skill in the art to include changing an intensity of a display of the picture to reflect an adjusted priority of the one of the remaining goals, an adjusted amount of time expected to achieve the one of the remaining goals, and replacing the picture with another picture representative of an adjusted quality of the one of the remaining goals . . . since the claimed

invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.”

Office Action at pages 24-25.

Applicant respectfully submits that in making the above assertions, unsupported by prior art references or Official Notice, the Office Action has simply made conclusory statements upon which a rejection of obviousness cannot be sustained. At best, the Office Action’s conclusory assertions could be considered assertions that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining *Jones* and *Maggioncalda* would not result in a predictable variation of Appellant’s invention because a hypothetical *Jones* and *Maggioncalda* combination, which, as noted above, would lack recited elements, would not result in the elements recited in claims 126-128 of the present application. Because it would lack a recited element of Appellant’s invention, it would not be a predictable variation of Appellant’s invention. Therefore, for claims 126-128 (and for claims 129-131 and claims 132-134, which, while of different scope from claims 126-128, recite claim elements similar to those recited in claim 126-128, respectively), no *prima facie* case of obviousness has been established in accordance with M.P.E.P. § 2141(II). Applicant submits that the rejection of claims 126-134 under 35 U.S.C. §103 as being obvious from *Jones* in view of *Maggioncalda* is thus improper and should be withdrawn.

VI. Conclusion

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the cited art.

Applicant therefore requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: November 9, 2009

By: 

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